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OFFICE OF PETITIONS

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In re Application of Pier et al.	:	
Application No. 10/712,391	:	Decision On Application For
Filing Date: November 12, 2003	:	Patent Term Adjustment
Attorney Docket No. B0801.70256US01	:	

This is a decision on the "Application for Patent Term Adjustment Under 37 CFR §1.705" filed February 24, 2010. Applicants submit the correct patent term adjustment to be indicated on the patent is five hundred forty-two (542) days, not eighty-four (84) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

Applicants request the correction to the patent term adjustment solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the

patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

The petition states,

The USPTO has indicated that a fee is not due for any requests for PTA recalculation based on a Wyeth delay. Accordingly, Applicants is not submitting ... the required fee.... However, if such fee is considered due or if any additional fee is considered due, please charge such fee(s) to Deposit Account No. 23/2825.

The Office has issued a notice discussing a procedure which may be followed in order to avoid payment of a fee in some cases involving “Wyeth delay.”² However, the procedure may not be used if a patent has not issued or if the patent issued on or after March 2, 2010. As stated in the notice,

The procedure set forth in this notice ... may not be used to request a reconsideration of the patent term adjustment indicated in the notice of allowance in an application that has not yet issued as a patent.... Patentees seeking a revised patent term adjustment in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d).³

In this case, the application for patent term adjustment was filed before issuance of the patent and the instant will not issue as a patent on a date prior to March 2, 2010. Therefore, the procedure set forth in the notice is inapplicable and the Office has charged the \$200 fee set forth in 37 CFR 1.18(e) to Deposit Account No. 23-2825.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

² Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply With the Federal Circuit Decision in *Wyeth v. Kappos* Regarding the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A), 75 *Fed. Reg.* 5043 (February 1, 2010).

³ *Id.* at 5044.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Supervisor
Office of Petitions